

**REMARKS**

The Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamamoto et al. (6,628,890), in further view of Thomason et al. (6,018,612).

Applicants respectfully traverse the §103 rejections with the following arguments.

**35 U.S.C. §103(a)**

The Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as allegedly being unpatentable over Yamamoto et al. (6,628,890), in further view of Thomason et al. (6,018,612).

Applicants respectfully contend that claims 1, 9, and 15 are not unpatentable over Yamamoto in further view of Thomason, because Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15.

As a first example of why Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15, Yamamoto in further view of Thomason does not teach or suggest the feature: **"receiving means for receiving first compressed data composed of a plurality of packets, said first compressed data including a plurality of programs multiplexed in a time division manner"** (emphasis added).

The Examiner quotes Yamamoto, col 4, lines 57-63 as reciting: "The demodulation/error correction unit 2 performs demodulation and error correction for the bitstream input from the tuner 1, converts the same into a transport stream [TS] defined by MPEG2 system, and output the TS to the demultiplexer unit 3. The demultiplexer unit 3 demultiplexes an audio or video PES packet of one program from the TS input" (emphasis added).

In response, Applicants respectfully contend that the preceding quote from Yamamoto does not disclose **"said first compressed data including a plurality of programs multiplexed in a time division manner"**.

In "Response to Arguments", the Examiner argues: "First, the claimed "plurality of

programs" is adequately broad to allow the audio and video signals in an MPEG bit stream to read on the limitation. Since Yamamoto discloses his transport stream to be MPEG2, which is defined as a time-multiplexed data stream, Yamamoto clearly discloses the claimed feature.... Further, even if the claim were read narrowly, the use of time-division multiplexing of multiple packetized data streams is well known to those of ordinary skill in the art at the time of the invention, and is a logical choice for the output of a tuner, particularly on a single digital bit stream. Time-division multiplexing is used in a variety of situations where multiple packetized bit streams must share a common line, such as IP based computer networks and satellite television."

In response, Applicants respectfully contend that: (1) the Examiner has not presented evidence from the prior art demonstrating that "is well known to those of ordinary skill in the art at the time of the invention, and is a logical choice for the output of a tuner, particularly on a single digital bit stream. Time-division multiplexing is used in a variety of situations where multiple packetized bit streams must share a common line, such as IP based computer networks and satellite television"; and (2) the Examiner has not presented an argument based on evidence from the prior art as to why it is allegedly obvious to modify Yamamoto by the preceding feature of claims 1, 9, and 15.

As a second example of why Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15, Yamamoto in further view of Thomason does not teach or suggest the following combination of features:

**"recording means for recording the second compressed data generated by the record control means in a same order in which the first compressed data is received by the receiving means; ...**

**reproduction control means for reading the second compressed data from the recording means and transmitting the second compressed data to the data reproducing means in a same order in which the second compressed data is recorded in the recording means"** (emphasis added).

Applicants respectfully contend that Yamamoto in further view of Thomason does not disclose the recited ordering of data relating to the recording means and reproduction control means in the preceding combination of features.

As a third example of why Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15, Yamamoto in further view of Thomason does not teach or suggest the feature: **"data reproducing means for decoding the compressed audio/video data included in the second compressed data simultaneous with additional second compressed data being recorded in the recording means"** (emphasis added).

As a fourth example of why Yamamoto in further view of Thomason does not teach or suggest each and every feature of claims 1, 9, and 15, Yamamoto in further view of Thomason does not teach or suggest the feature: **"time division control means for controlling the transmitting and reading of the second compressed data to and from the recording means in a time division manner ...."**

The Examiner admits: "Yamamoto et al do not disclose a means for controlling the transmitting and reading of the data to and from the recording means in a time division manner".

The Examiner alleges that Thomason discloses the preceding feature of claims 1, 9, and 15, and argues as follows why it is obvious to modify Yamamoto with the alleged teaching of Thomason: "As taught by Thomason et al, time division multiplexing of a read/write head allows for apparent **simultaneous recording and reproduction**, which improves the performance of the recording and reproducing apparatus and increases its value to the user" (emphasis added).

In response, Applicants respectfully contend that the Examiner has not supplied a legally persuasive argument as to why a person of ordinary skill in the art would modify Yamamoto by the alleged teaching of Thomason in relation to claims 1, 9, and 55. In particular, established case law requires that the prior art must contain some suggestion or incentive that would have motivated a person of ordinary skill in the art to modify a reference or to combine references. See *Karsten Mfg. Corp. V. Cleveland Gulf Co.*, 242 F.3d 1376, 58 U.S.P.Q.2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching **in the prior art** that would have led a person of ordinary skill in the art to select the references and combine them in a way that would produce the claimed invention"). See also *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the motivation obvious **unless the prior art suggested the desirability of the modification.**").

Applicants maintain that the Examiner has not made any showing of where the prior art suggests "time division control means for controlling the transmitting and reading of the second compressed data to and from the recording means in a time division manner" for the purpose of

**“simultaneous recording and reproduction”**. Indeed, the Examiner appears to have learned of this advantage from Applicants’ specification, which recites the following object of the invention on page 3, lines 6-8: “An object of the present invention is to provide an apparatus for recording and reproducing digital data, which is capable of recording digital broadcast data while reproducing previously- recorded digital broadcast data.” In support of Applicants’ position, see *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991) (reversing the Board’s obviousness rejections, and noting that the primary reference failed to suggest the modification alleged to be obvious, and stating that “the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant’s disclosure.”)

In “Response to Arguments”, the Examiner alleges that Yamamoto discloses the preceding feature of claims 1, 9, and 15, but is unable to provide a single citation from Yamamoto that supports the Examiner’s allegation.

Based on the preceding arguments, Applicants respectfully maintain that claims 1, 9, and 15 are not unpatentable over Yamamoto in further view of Thomason, and that claims 1, 9, and 15 is in condition for allowance. Since claims 2-3 and 5-8 depend from claim 1, Applicants contend that claims 2-3 and 5-8 are likewise in condition for allowance. Since claims 10-11 and 13-14 depend from claim 9, Applicants contend that claims 10-11 and 13-14 are likewise in condition for allowance. Since claims 16 and 18-20 depend from claim 15, Applicants contend that claims 16 and 18-20 are likewise in condition for allowance.

In addition with respect to claims 5, 14, and 18, Applicants maintain that Yamamoto in further view of Thomason does not teach or suggest the feature: “monitoring means for

monitoring the amount of data transmitted from the reproduction control means to the data reproducing means".

The Examiner quotes Yamamoto, col 8, line 66 - col. 9, line 1 as reciting: "the navigation control block 22 instructs the data transfer to the PES packet reading block 21 according to an available space in the PES packet buffer 23".

In response, Applicants refer to previous arguments by the Examiner in order to apply a logically consistent review of the Examiner's analysis of claims 5, 14, and 18. The Examiner alleges that the navigation control block 22 of Yamamoto represents the "monitoring means" in the Examiner's analysis of claim 5. The Examiner alleges that the navigation control block 22 of Yamamoto represents the "reproduction control means" in the Examiner's analysis of claim 4. The Examiner alleges that the AV decoder 24 of Yamamoto represents the "data reproducing means" in the Examiner's analysis of claim 1.

In application to the language of claim 5 with logical consistency, the Examiner is therefore arguing that Yamamoto discloses: monitoring means (22) for monitoring the amount of data transmitted from the reproduction control means (22) to the data reproducing means (24). First, the preceding statement inferred from the Examiner's analysis does not make any sense. Second, claim 5 requires monitoring of data from the reproduction control means (22) to the data reproducing means (24) which Yamamoto most certainly does not disclose.

Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 5, 14, and 18.

In addition with respect to claims 6, 13, and 19, Applicants maintain that Yamamoto in

further view of Thomason does not teach or suggest the feature: "switching means for switching between transmitting the compressed audio/video data extracted by the data separating means to the data reproducing means and transmitting the second compressed data from the reproduction control means to the data reproducing means"

Therefore, Applicants respectfully contend that the Examiner has not established a *prima facie* case of obviousness in relation to claims 6, 13, and 19.

CONCLUSION

Based on the preceding arguments, Applicants respectfully believe that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicants invites the Examiner to contact Applicants' representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

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Jack P. Friedman  
Jack P. Friedman  
Registration No. 44,688

Schmeiser, Olsen & Watts  
3 Lear Jet Lane, Suite 201  
Latham, New York 12110  
(518) 220-1850